

### Remarks

Claims 1-107 were pending in the application. All of the pending claims were rejected to for various reasons that are described below. Claims 1-107 have been canceled without prejudice or disclaimer to the subject matter recited therein, and claims 108-171 have been added. Claims 108, 137, 149, 154, 166 and 170 are the independent claims.

In paragraph one of the Office Action, the Examiner stated that the declaration was defective because several inventors did not date their signature. A substitute declaration is enclosed with this Amendment. However, the Applicant points out that per MPEP § 602.05 the date of execution is no longer required.

In paragraphs 2 and 3 of the Office Action, the Examiner states that the application fails to claim priority because the application number was incomplete as written in the specification “(60/???,???)”. The applicant submits that the application number for the provisional application was not known (Filing Receipt had not been received from the USPTO) at the time of the filing of this application. The applicant has amended the specification to include the complete application number for the provisional application 60/347,104 for Attorney docket number T742-00 filed on January 9, 2002. In addition, the Applicant submits a copy of the filing receipt for the provisional application showing the docket number and filing date with associated application number. The applicant submits that the priority for this application should now be recognized by the Examiner.

In paragraph 4 of the Office Action, the Examiner objected to the specification because the provisional application number was missing. As noted above with respect to paragraphs 2 and 3 of the Office action, the specification has been amended. The objection should according be withdrawn.

In paragraph 5 of the Office Action, the Examiner states that the application lists 46 related applications at pages 1-6 of the application without a statement regarding the relevance

thereof. Accordingly, the Examiner did not consider the references. Applicant submits that pages 1-6 list all the relevant data for the incorporated references, and that within the specification the specific relevance of these incorporate references is defined. For example, on page 20 lines 14 and 15 the application refers to specific applications for more details about what was just described. For the foregoing reasons it is submitted that the Examiner should consider these applications.

An IDS and 1449 identifying each of these applications, publications and/or patents is included with this Amendment. US national phase applications that have not yet been published (09/857,256 (Docket No. T702-15), 09/857,160 (T705-13), and 09/807,887 (Docket No. T706-11)) are not included because they are nothing more than the PCT application at this point. Copies of the references are also included with this Amendment. Copies of US patents and US publications are not included.

In paragraphs 6 and 7 of the Office Action, the Examiner rejected claims 33-44 and 78-87 under 35 USC 112, second paragraph as being indefinite because claims 33 and 78 recited “method” when it should have been “system”. Claims 33-44 and 78-87 have been canceled without prejudice or disclaimer to the subject matter contained therein and it is submitted that this rejection is not applicable to the newly added claims. Accordingly, the rejection should be withdrawn.

In paragraph 8 and 9 of the Office Action, the Examiner rejects claims 1-73 and 78-89 under 35 USC §103(a) as being unpatenable over *Hendricks et al.* (USP 6,463,585) in view of *Labeeb et al.* (US Publication 2003/0093792). In paragraph 10 of the Office Action, the Examiner rejects claim 74 under 35 USC §103(a) as being unpatenable over *Hendricks et al.* in view of *Labeeb et al.* and *Hite et al.* (USP 6,002,393). In paragraph 11 of the Office Action, the Examiner rejects claims 75-77 and 90-107 under 35 USC §103(a) as being unpatenable over *Hendricks et al.* in view of *Labeeb et al.* and *Barton* (US Publication 2001/0049820). It is submitted that claims 108-171 are patentable over the cited references for at last the reasons described below.

Independent claim 108 is directed to a method for delivering targeted advertisements to a subscriber with video that the subscriber selected to receive from a video on demand system. The method includes selecting the video and determining available advertisement opportunities in the selected video. Advertisement profiles are received. The advertisement profiles define advertisement traits and intended target market traits for associated advertisements. The intended target market traits include criteria related to specific transactions of subscribers. The criteria includes presence of the specific transactions, absence of the specific transactions, or presence of a first subset of the specific transactions and absence of a second subset of the specific transactions. A first set of advertisements capable of being delivered with the video is selected by comparing the advertisement traits and the available advertisement opportunities. A second set of advertisements that are of interest to a subscriber is selected by comparing the intended target market traits and subscriber transaction data. The comparing includes searching the subscriber transaction data for the presence of the specific transactions, the absence of the specific transactions, or the presence of a first subset of the specific transactions and the absence of a second subset of the specific transactions. Targeted advertisements are selected that include advertisements that are part of both the first set of advertisements and the second set of advertisements. The selected video and the targeted advertisements are delivered to the subscriber.

It is submitted that none of the cited references disclose or suggest a method as recited in independent claim 108. For example, none of the cited references disclose or suggest intended target market traits that include criteria related to specific transactions of subscribers (e.g., presence of the specific transactions, absence of the specific transactions, or presence of a first subset of the specific transactions and absence of a second subset of specific transactions), or selecting advertisements that are of interest to a subscriber by comparing the intended target market traits and subscriber transaction data (e.g., searching the subscriber transaction data for the presence of the specific transactions, the absence of the specific transactions, or the presence of a first subset of the specific transactions and the absence of a second subset of specific transactions). In fact, on page 5 of the Office Action, the Examiner states that *Hendricks et al.* do not disclose “the advertisement profile define traits for an intended target market of the associated advertisement, wherein the intended target market traits include presence or absence

of specific transactions; searching associated subscriber transaction data for the presence or absence of the specific transactions defined in the intended target market traits”.

The Examiner relies on *Labeeb et al.* for teaching “wherein the intended target market traits include presence or absence of specific transactions, and searching associated subscriber transaction data for the presence or absence of the specific transactions defined in the intended target market traits (see paragraph 0233, line 6+)”. The Applicant contends that the Examiners assertion is erroneous as this section of *Labeeb et al.* do not disclose or suggest these features. To the contrary, this section defines generating viewing profiles based on the monitored viewing selections of various users. Based on these viewing profiles the system generates top ten lists. There is clearly no disclosure or suggestion in this section of *Labeeb et al.* of intended target market traits that include presence of the specific transactions, absence of the specific transactions, or presence of a first subset of the specific transactions and absence of a second subset of the specific transactions, or selecting advertisements that are of interest to a subscriber by comparing the intended target market traits and subscriber transaction data, as required by claim 108. Moreover, it is submitted that neither the remainder of *Labeeb et al.*, *Hite et al.* nor *Barton* disclose or suggest these features.

For at least the reasons discussed above, it is submitted that claim 108 is patentable over the cited references. Claims 109-136 depend from claim 108 and are submitted to be patentable for at least the reasons described above with respect to claim 108 and for the further features recited therein. Independent claims 137 and 149 are system and computer program claims respectively. These claims are submitted to be patentable over the cited references for at least reasons similar to those advanced above with respect to claim 108. Claims 138-148 and 150-153 depend therefrom and are submitted to be patentable over the cited references for at least the same reasons as the claims they depend from and for the further features recited therein. Accordingly it is submitted that claims 108-153 are patentable over the art of record.

Independent claim 154 is directed to a method for delivering targeted advertisements to a subscriber with video that the subscriber selected to receive from a video on demand system. The method includes selecting the video and determining available advertisement opportunities in the selected video. Advertisement profiles defining advertisement traits and intended target

market traits for an associated advertisement are received. A first set of advertisements capable of being delivered with the video is selected by comparing the advertisement traits and the available advertisement opportunities. A second set of advertisements that are of interest to a subscriber is selected by comparing the intended target market traits and some combination of a subscriber profile that defines traits associated with the subscriber, household demographics, traits associated with the selected video, or traits associated with previously selected videos. Targeted advertisements are selected and include a subset of advertisements that are part of both the first set of advertisements and the second set of advertisements. The selected video and the targeted advertisements are delivered to the subscriber and presented to the subscriber on a viewing device. An alternative advertisement that is a shortened version of the targeted advertisement is presented when the subscriber fast-forwards or skips the targeted advertisement.

It is submitted that none of the cited references disclose or suggest a method as recited in independent claim 154. For example, none of the cited references disclose or suggest an alternative advertisement that is a shortened version of the targeted advertisement is presented when the subscriber fast-forwards or skips the targeted advertisement. In fact, on page 27 of the Office Action, the Examiner states that neither *Hendricks et al.* nor *Labeeb et al.* disclose “presenting an alternative advertisement when the subscriber fast-forwards or skips the targeted advertisement”. The Examiner relies on *Barton* to disclose an alternative advertisement (next ad when fast-forwarded). Claim 154 clarified that the alternative ad is a shortened version of the targeted ad. There is clearly no disclosure or suggestion in *Barton* of presenting an alternative advertisement that is a shortened version of the targeted advertisement when the subscriber fast-forwards or skips the targeted advertisement, as required by claim 154.

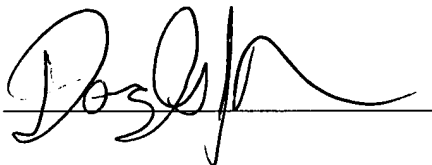
For at least the reasons discussed above, it is submitted that claim 154 is patentable over the cited references. Claims 155-165 depend from claim 154 and are submitted to be patentable for at least the reasons described above with respect to claim 154 and for the further features recited therein. Independent claims 166 and 170 are system and computer program claims respectively. These claims are submitted to be patentable over the cited references for at least reasons similar to those advanced above with respect to claim 154. Claims 167-169 and 171 depend therefrom and are submitted to be patentable over the cited references for at least the same reasons as the claims they depend from and for the further features recited therein. Accordingly it is submitted that claims 154-171 are patentable over the art of record.

## Conclusion

For the foregoing reasons, Applicant respectfully submits that claims 108-171 are in condition for allowance. Accordingly, early allowance of claims 108-171 is earnestly solicited.

If the Examiner believes that a conference would be of value in expediting the prosecution of this Application, the Examiner is hereby invited to contact the undersigned attorney to set up such a conference.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Douglas J. Ryder', is written over a horizontal line.

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